

**Notice of Allowability**

Application No.

09/787,986

Applicant(s)

LEWIS ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/6/04.
2. ☒ The allowed claim(s) is/are 35-39.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 17.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 05/04/04.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Art Unit: 1653

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Frank DiGiglio and Xiaochun Zhu on May 11, 2004.

**Examiner's Amendments to the Specification:**

Please insert the following paragraph at page 1 after the title:

This application is a 371 of PCT/AU99/00844, filed October 1, 1999, which claims priority to Australia Patent Application Serial No. PP 6274, filed October 1, 1998.

**Examiner's Amendments to the Claims:**

Claims 35-38 have been amended and a new claim 39 has been added as follows:

35. (Currently amended) An isolated, synthetic or recombinant  $\chi$ -conotoxin peptide having the [ability to inhibit] activity of inhibiting a neuronal amine transporter, wherein said  $\chi$ -conotoxin peptide [is selected from] comprises MrIA as set forth in SEQ ID NO: 1 (NGVCCGYKLCHOC), or MrIB as set forth in SEQ ID NO: 2 (VGVCCGYKLCHOC), and wherein "O" represents 4-hydroxyproline.

36. (Currently amended) An isolated, synthetic or recombinant  $\chi$ -conotoxin peptide having the [ability to inhibit] activity of inhibiting a neuronal amine transporter, wherein said  $\chi$ -conotoxin peptide is MrIA as set forth in SEQ ID NO: 1 (NGVCCGYKLCHOC), and wherein "O" represents 4-hydroxyproline.

37. (Currently amended) An isolated, synthetic or recombinant  $\chi$ -conotoxin peptide having the [ability to inhibit] activity of inhibiting a neuronal amine transporter, wherein said  $\chi$ -conotoxin peptide is MrIB as set forth in SEQ ID NO: 2 (VGVCCGYKLCHOC), and wherein "O" represents 4-hydroxyproline.

38. (Currently amended) A method for the treatment or control of pain in a mammal comprising administering to the mammal an [effective] amount of a  $\chi$ -conotoxin peptide [according to any one of claims 35-37] effective to control pain, wherein  $\chi$ -conotoxin peptide comprises MrIA as set forth in SEQ ID NO: 1

Art Unit: 1653

(NGVCCGYKLCHOC), or MrIB as set forth in SEQ ID NO: 2 (VGVCCGYKLCHOC), and wherein "O" represents 4-hydroxyproline.

39. (New) A method for the treatment or control of pain in a mammal comprising administering to the mammal an amount of a  $\chi$ -conotoxin peptide effective to control pain, wherein  $\chi$ -conotoxin peptide is selected from MrIA as set forth in SEQ ID NO: 1 (NGVCCGYKLCHOC), or MrIB as set forth in SEQ ID NO: 2 (VGVCCGYKLCHOC), and wherein "O" represents 4-hydroxyproline.

**The following is an Examiner's Statement of Reasons for Allowance:**

The prior art does not teach a  $\chi$ -conotoxin peptide having the activity of inhibiting a neuronal amine transporter and comprising MrIA (SEQ ID NO: 1) or MrIB (SEQ ID NO: 2), and a method for the treatment or control of pain by administering an effective amount of the  $\chi$ -conotoxin peptide to the mammal. Therefore, the claims are allowable over the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

\*\*\*

May 11, 2004

*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800